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- print information producing means for producing print information for printing the image information, the print information including print designating information which designates an image to be printed; and transmitting means for transmitting the image information and the print information to an external apparatus.
2. The camera of claim 1, wherein the print information producing means produces the print information further including print quantity information, which expresses a quantity of prints, and the transmitting means transmits the image information and the print information including the print designating information and the print quantity information.

REMARKS

In the last Office Action dated October 10, 2001, the Examiner: rejected claims 1-13 and 17-21 under 35 U.S.C. § 102(e) as being anticipated by Enomoto et al. (U.S. Pat. No. 5,974,401); rejected claims 1-3 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. (U.S. Pat. No. 6,006,039) in view of Cloutier et al. (U.S. Pat. No. 5,229,810); rejected claims 4-5 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Saegusa (U.S. Pat. No. 5,799,217); rejected claims 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Friend et al. (Understanding Data Communications); and rejected claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Kaihatsu (U.S. Pat. No. 5,898,386).

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Claims 1-13 and 17-25 are pending in this application, with claim 1 being only independent claim. By this amendment, Applicants amend claims 1 and 2. No new matter has been entered.

Applicants respectfully request reconsideration and withdrawal of the objections and rejections set forth in the above-identified Office Action.

REJECTION UNDER 35 U.S.C. § 102(b)

The Examiner rejected claims 1-13 and 17-21 under 35 U.S.C. § 102(e) as being anticipated by Enomoto et al. (U.S. Pat. No. 5,974,401). Applicants respectfully traverse this rejection.

Before discussing the prior art in detail, it is believed that a brief review of the present invention as claimed would be helpful. Independent claim 1 recites a camera comprising image-pickup means for receiving light to form an image of a subject, for converting the light into electric signals and for producing image information of the image of the subject by the electric signals, print information producing means for producing print information for printing the image information, the print information including print designating information which designates an image to be printed, and transmitting means for transmitting the image information and the print information to an external apparatus.

The present invention is characterized in that the camera has in "itself" print information producing means and transmitting means. The print information produced by the print information producing means includes print designating information. The transmitting means then transmits the print information including print designating information to an external apparatus, so that print order can be placed by the camera.

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Conventionally, where image information produced by an electronic camera is recorded in a removable memory, the memory is brought to a print shop by the user and a troublesome ordering procedure is required for the user at the print shop to print the image. However, according to the present invention, such troublesome steps can be eliminated because a camera with the features of the present invention, as claimed, can directly produce and transmit an order information as well as the image information without using any other external apparatus, such as a personal computer.

Furthermore, where a user wants to place an order for a print without going to the print shop, the user can place the order by using the camera of the present invention without using a personal computer or the like, since the camera itself is able to generate the print information and transmit the print information to an external apparatus for a print. This is a great advantage for a user who does not possess a personal computer.

As will be described below, the cited reference does not teach or suggest the claimed invention, because it fails to disclose all the claimed features of the present invention.

In order for a claim to be anticipated by a prior art reference under 35 U.S.C. § 102, all elements of the claim must be present in the reference. “A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131.

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Enomoto et al. discloses a digital print order and delivery method and system. According to the method and system, digital image data is input in a personal computer (11), through an image input device, e.g. a scanner (20) or a digital still camera (21). The order sender processes the image data with reference to a display on the screen of the personal computer (11), and then inputs print order data.

As becomes apparent, Enomoto et al. does not teach or suggest the claimed invention because it fails to disclose, *inter alia*, a camera having print information producing means for producing print information for printing the image information and transmitting means for transmitting the print information to an external apparatus. The digital camera (21) of Enomoto et al. only sends digital image data to a personal computer (21). That is, rather than the camera itself producing the print information for printing the image information and transmitting the print information to an external apparatus, it is the personal computer (21), more specifically image processing-ordering software installed in the personal computer, that produces print information and transmits the print information to an external apparatus. Therefore, with the camera disclosed by Enomoto et al., a user without a personal computer still needs to go to the print shop and must go through the troublesome ordering procedure to place a print order, since the print information cannot be produced or transmitted.

For the reasons set forth above, Applicants believe that the claimed invention is not anticipated by Enomoto et al. and, thus, respectfully request reconsideration and withdrawal of the rejection.

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REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected claims 1-3 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. (U.S. Pat. No. 6,006,039) in view of Cloutier et al. (U.S. Pat. No. 5,229,810). Applicants respectfully traverse this ground of rejection.

Claim 1 is discussed above in detail. Applicants urge that combination of Steinberg et al. and Cloutier et al. does not teach or suggest the claimed invention because it fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

"The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992) (Emphasis original). Thus, the Examiner must follow the criteria necessary to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143. Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Additionally, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). As will be described below, combination of the cited

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references fails to establish a *prima facie* case of obviousness under 35 U.S.C. § S.C. § 103(a).

Steinberg et al. discloses a camera having behavioral parameters and graphics information that can be configured through external means. The camera of Steinberg et al., designed to input and output data by means of either a port or a slot, allows downloading of a variety of camera configuration data from an external means (such as a PC or another camera via a cable, a card, or modulated radiated signals) and transmitting of image data along with required image textural graphic data to external means.

Cloutier et al. discloses film information exchange system using dedicated magnetic tracks on film. A virtually transparent magnetic layer (120) is included as an additional layer in a photographic film strip (100). Information exchange between various users of the film is facilitated by plural longitudinal magnetic tracks on the film (110) that begin and end within individual frames. Each track is dedicated to the writing and reading of a predetermined set of parameters relating to the corresponding frame, for easy access by a particular one of the various users.

As to the first criterion for a proper *prima facie* case of obviousness, the combination of Steinberg et al. and Cloutier et al. does not teach or suggest all the claimed elements because it fails to disclose, *inter alia*, print information producing means for producing print information for printing the image information, the print information including print designating information which designates an image to be printed, and transmitting means for transmitting the image information and the print information to an external apparatus.

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While the Examiner admits that Steinberg et al. does not teach the print information including print designating information which designates an image to be printed, the Examiner alleges that "Cloutier et. al. teaches in figure 7, that it was known to input and record such data in a camera." However, it should be pointed out that, as clearly shown in Fig. 7, the print information is recorded at the retail order station, not by a camera. Moreover, since Coutier et al. relates to a camera for recording images in the film and magnetically recording the data in the magnetic track on the film, the image information or print information recorded onto the film cannot be transmitted to an external apparatus by neither cameras of Coutier et al. or Steinberg et al.

For these reasons set forth above, Applicants urge that the first criterion for a proper *prima facie* case of obviousness has not been met.

As to the second criterion, there is no suggestion or motivation in the aforementioned references to combine or modify the teachings of the references. Furthermore, the Examiner also has failed to provide any evidence showing that such suggestion or motivation is in the knowledge generally available to one of ordinary skill in the art. Therefore, Applicants urge that the second criterion for a proper *prima facie* case of obviousness also has not been met.

Finally, as to the third criterion, the combination of cited references does not result in the present invention as claimed and the combination does not provide a reasonable expectation of success because it is unclear as to how the photographic film of Cloutier et al. could be incorporated in the device of Steinberg et al. Even if the film of Cloutier et al. properly could be incorporated into the device of Steinberg et al., it is still unclear as to how the print information recorded on the film could be transmitted by

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the camera to an external means. Moreover, a teaching or suggestion of how to make the claimed combination and the reasonable expectation of success is not found in the cited references. Therefore, Applicants urge that the third criterion for a proper *prima facie* case of obviousness also has not been met.

For the reasons set forth above, the Applicants believe that a *prima facie* case of obviousness has not been established and respectfully request reconsideration and withdrawal of this ground of rejection.

The Examiner further rejected claims 4-5 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Saegusa (U.S. Pat. No. 5,799,217), rejected claims 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Friend et al. (Understanding Data Communications), and rejected claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Steinberg et al. in view of Cloutier et al., and further in view of Kaihatsu (U.S. Pat. No. 5,898,386).

Applicants believe that claims 2-13 and 17-21 are in condition for allowance at least because of their dependencies on allowable independent claim 1.
Reconsideration and withdrawal of these rejections are respectfully requested.

CONCLUSIONS

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-13 and 17-25 in condition for allowance. Applicants submit that the proposed amendment of claims 1 and 2 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier

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claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that the claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Attached hereto is a marked-up version of the changes made to the claims 1 and 2 by this Amendment.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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APPENDIX TO AMENDMENT

IN THE CLAIMS:

1. A camera[,] comprising:

image-pickup means for receiving light to form an image of a subject, for
converting the light into electric signals and for producing image
information of the image of the subject by the electric signals;
print information producing means for producing print information for
printing the image information, the print information including print
designating information[,] which designates an image to be printed[,
and image quantity information, which expresses a quantity of prints];
and
transmitting means for transmitting the image information and the print
information to an external apparatus.

2. The camera of claim 1, wherein [the image information and the print information
are correlated with each other by the transmitting means when the image
information and the print information are transmitted] the print information
producing means produces the print information further including print quantity
information, which expresses a quantity of prints, and the transmitting means
transmits the image information and the print information including the print
designating information and the print quantity information.

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